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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,778	01/07/2002	Michihiro Kawada	TSUT8.001 APC	6363

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EXAMINER

BUTLER, DOUGLAS C

ART UNIT PAPER NUMBER

3683

DATE MAILED: 01/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

Office Action Summary

Application N .

10/030,778

Applicant(s)

KAWADA ET AL.

Examiner

Douglas C. Butler

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9 29 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 2, 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8 and 10-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. An action on the merits of claims 1, 3-6 and 10-16 considered readable on Species B (Figures 6-8) is included in this office action with claims 2 and 7-8 being withdrawn from consideration. 37 C.F.R. § 1.142(b). Election was made without traverse in Paper No. 6 filed on September 29, 2003.

Claim 1 is generic.

2. Claim 9 has been canceled.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Applicant and/or assignee should maintain this clear line of patentable distinction between the instant claims and the claims of applicants' S.N. 10/129,706.

If available, applicants should submit copies of any documents cited in PCT/JP01/06473 which corresponds to applicant's S.N. 10/129,706.

5. The instant submitted Search Report for PCT/JP01/04091 which corresponds to this application 10/030,778 has been considered as has the submitted prior art been considered.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3683

7. Claims 4-6 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There are no clear antecedents bases in the claims for "the... hole" of claim 4, line 2, claim 5, line 2, claim 12, line 2 and "the bolt" and "the nut" of claim 10, lines 7 and 8.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishino(US6244607).

Note attachment piece 14, attachment plate 30, 17, nuts 28 of the strut mount of Figure 2 of Nishino(US6244607). Note inner and outer members near numerals 37 and 26.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3683

11. Claims 3-6, 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishino(US6244607) in view of Capuano(4432681) or Pamer et al(6220804) .

The principal reference to Nishino discloses the invention substantially as claimed except for the feature the particular caulking nut, i.e., a nut of hard material deforming or biting by teeth, grooves or corrugations a softer material (the attachment portion of attachment plate 28 of instant invention) to secure a nut to a attachment piece to avoid the nut from loosening during use and assembly. The nuts 28 of Nishino(US6244607) do not appear to be caulking type nuts.

The secondary references to Capuano (4432681) and Pamer et al (6220804) teach the use of caulking nuts for the purpose of fastening a nut and sheet wherein the nut has a cylindrical portion with corrugations .

It would have been obvious at the time the invention was made to one having ordinary skill in the art to which the invention pertains to modify the principal reference to Nishino (US6244607) to connect the elements of the strut mount together by the use of a caulking nut similar to that of Capuano (4432681) or Pamer et al (6220804) since caulking nuts are routinely used to hold nuts in place during assembly of the components to avoid separation of the components and loss of assembly parts during use, servicing, repair, etc.

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

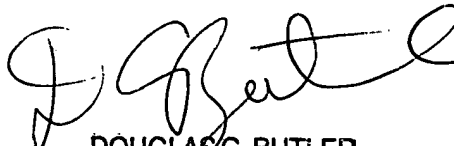
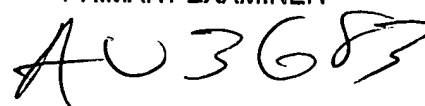
Art Unit: 3683

1992). In this case, the caulking nut fasteners of Capuano (4432681) or Pamer et al (6220804) are concerned with the same problem of the nuts 78 of Nishino, i.e., to securely fasten the strut components together and to maintain the integrity of the fastening. To use a caulking nut facilitates and promotes the integrity of the fastening system.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Butler whose telephone number is (703) 308-2575. The examiner is normally in the USPTO Monday-Friday from 5:30 a.m. to 2:00p.m. Although the examiner may not always be present in his office to immediately answer the phone when called, the examiner will make every effort to return the call as soon as possible. If the examiner does not answer his phone, the examiner suggests that a brief message be recorded on the examiner's voice mail machine when necessary and appropriate. The examiner normally checks recorded phone calls at least once a day unless on leave.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


DOUGLAS C. BUTLER
PRIMARY EXAMINER
 12/19/03